

(18) Interim Waiver of 37 C.F.R. 1.84(b)(1)  
for Petitions to Accept Black and White  
Photographs and Advance Notice of  
Change to M.P.E.P. 608.02

The Patent and Trademark Office (PTO) is sua sponte waiving 37 C.F.R. 1.84(b)(1) to the extent that a petition and petition fee are no longer required in order to accept black and white photographs in lieu of drawings. The reason for this waiver is that the PTO intends to amend 37 C.F.R. 1.84(b)(1) to eliminate the requirement for a petition and petition fee.

Because a significant period of time will elapse before any final rule change can be promulgated, effective as of the publication date of this notice, the PTO will, sua sponte, waive 37 C.F.R. 1.84(b)(1) to the extent that a petition and petition fee are no longer required for acceptance of black and white photographs in applications that are pending as of the publication date of this notice or any applications filed thereafter. If an Office action has been mailed which requires a petition under 37 C.F.R. 1.84(b)(1) and/or a petition fee, an acceptable reply to the Office action would be a reference to this notice and a request that the requirement be withdrawn. However, any petition fees set forth in 37 C.F.R. 1.17(i) which were paid prior to the publication date of this notice will not be refunded, since they were required at the time they were paid. A fee authorized to be charged to a deposit account is considered to have been paid on the date the paper with the authorization was filed. Any petition fees set forth in 37 C.F.R. 1.17(i) paid or authorized to be paid after the publication date of this notice will not have been required at the time the fees were paid or authorized and may be refunded. See 37 C.F.R. 1.26(a). Manual of Patent Examining Procedure, Section 608.02 will be amended consistent with this Notice.

Background of 37 C.F.R. 1.84(b)(1) and Rationale for Amendment

Currently, under 37 C.F.R. 1.84(b)(1), the PTO will accept black and white photographs in utility and design patent applications in lieu of drawings upon the granting of a petition to accept the photographs. However, petitions under 37 C.F.R. 1.84(b)(1) do not serve a useful purpose in the examination process and therefore unnecessarily delay the issuance of patents containing black and white photographs. As noted in "Interim Waiver of 37 C.F.R. 1.84(b)(1) for Petitions to Accept Black and White Photographs Filed with Only One Set of Photographs," 1211 O.G. 34 (June 9, 1998), the PTO can now process black and white photographs for design and utility applications in the same manner as drawings for design and utility applications. Since the special handling process has been eliminated, a petition is no longer necessary. In addition, the requirement for a petition for black and white photographs as set forth in 37 C.F.R. 1.84(b)(1) does not address when black and white photographs are acceptable in an application instead of drawings. Manual of Patent Examining Procedure (MPEP), section 608.02, states that the photographs or photomicrographs "must show the invention more clearly than they can be done by India ink drawings," but 37 C.F.R. 1.84(b)(1) does not include this language. Accordingly, petitions under 37 C.F.R. 1.84(b)(1) are grantable if the petition fee set forth in 37 C.F.R. 1.17(i) is included and the photographs are either properly mounted or on double weight photographic paper, even though photographs may not be acceptable instead of drawings in that application because the subject matter is capable of illustration by a drawing. See 37 C.F.R. 1.81(c). For example, a photograph of a syringe would not be acceptable if the syringe is capable of being drawn. In addition, the requirement of a petition to accept black and white photographs leads to delays in issuance of patents containing photographs (increases the

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cycle time of applications with photographs) and misuses valuable resources for several reasons. First, the petitions take time to decide, which adds to the processing time of applications with black and white photographs. Second, an added delay is caused by the practice of applicants first filing petitions under 37 C.F.R. 1.84(b)(1) while applications are being prepared for issuance and are no longer in the Technology Centers, where such petitions are decided, which requires applications with the petition and photograph(s) to be returned to the Technology Centers for treatment of the petitions. For these reasons, the requirement of 37 C.F.R. 1.84(b)(i) for a petition and petition fee should be eliminated.

This change in procedure should not change the number of applications in which photographs are filed. Photographs continue to be acceptable only in applications in which the invention is not capable of being illustrated in an ink drawing or where the invention is shown more clearly in a photograph. For example, photographs or photomicrographs of electrophoresis gels, blots, e.g., immunological, western, Southern, and northern, autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, metallurgical microstructures, textile fabrics, grain structures, and ornamental effects continue to be acceptable.

If a photograph that is filed in an application shows an invention which is capable of illustration, the examiner will, pursuant to 37 C.F.R. 1.81(c) and/or 37 C.F.R. 1.83(c), require a drawing of the subject matter. For example, syringes are capable of being drawn and drawings would generally demonstrate the details thereof more clearly (for example, cross hatching can be included to show the materials used). If a photograph (or a copy of a photograph) of a syringe is filed with the application, the examiner should require a drawing in lieu of the photograph. If the subsequently submitted drawing contains new matter, however, the examiner will not approve entry of the drawing, so applicants should be careful when initially submitting photographs instead of drawings. See MPEP 608.02(h) and 608.04. (The issue of new matter can also arise if a poor quality photograph or a photocopy of a photograph which is a poor reproduction is originally submitted and a better quality or the original photograph is later submitted and shows details beyond that shown in the photograph or photocopy that was originally submitted.)

It is noted that this change in procedure only applies to black and white photographs for utility and design applications. The current requirements for petitions for color drawings or color photographs are not affected. Color drawings and color photographs require special handling in the Office and the requirement for a petition is one mechanism for ensuring that these applications are properly processed. Thus, a petition, petition fee, and a reference in the specification continue to be necessary in design and utility applications for color drawings or color photographs to be accepted under 37 C.F.R. 1.84(a)(2).

If there are any questions or comments about this change in practice, they should be forwarded to Karin Tyson, Senior Legal Advisor, by facsimile at (703) 308-6916, by telephone at (703) 305-9285, or by e-mail at [karin.tyson@uspto.gov](mailto:karin.tyson@uspto.gov).

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STEPHEN G. KUNIN  
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(19) Interim Waiver of 37 C.F.R. 1.84(b)(1) for  
Petitions to Accept Black and White Photographs  
Filed with Only One Set of Photographs

The Patent and Trademark Office (PTO) is sua sponte waiving 37 C.F.R. 1.84(b)(1)(ii) to the extent that only a single set of black and white photographs need be submitted with a petition to accept black and white photographs in lieu of drawings. The reason for this waiver is that the PTO intends to amend 37 C.F.R. 1.84(b)(1) to reduce the requirement for the submission of three (3) sets of black and white photographs, as part of a petition to accept the photographs, to one set of black and white photographs as a result of patent printing process changes.

Because a significant period of time will elapse before any final rule change can be promulgated, effective as of the publication date of this notice, the PTO will, sua sponte, waive 37 C.F.R. 1.84(b)(1)(ii) to the extent that the submission of a single set (as opposed to three sets) of black and white photographs will be considered acceptable upon the filing a petition under 37 C.F.R. 1.84(b)(1).

Background of 37 C.F.R. 1.84(b)(1) and Rationale for Amendment

Under the existing rule, the PTO will accept black and white photographs in utility and design patent applications in lieu of drawings upon the granting of a petition to accept the photographs. The petition must include the fee set forth in 37 C.F.R. 1.17(i) and three (3) sets of photographs.

Until just recently, PTO processing of black and white photographs for utility and design applications required three sets of photographs. One of the three sets of photographs was retained in the application file as part of the official file record so it could be used during the examination process. The second and third sets of photographs were used when the application was being prepared for publication as a patent. At that time, the first set of photographs was used for optical scanning to create a scanned version of the photograph for the patent publishing database, and a special handling process would begin with the separate creation of three sets of headers. A header contains the patent number, issue date, and drawing sheet number. The three sets of headers were respectively applied to each sheet of each set of photographs. The second set of photographs was forwarded to the Patent and Trademark Copy Sales (PTCS) Office for use by PTCS as a master set for creating additional copies of the photographs when patent copies were sold to the public and the public requested that the copies be made from the original photograph(s) rather than the published patent. The third set of photographs was used in the official patent grant which was sent to the patentee. This special handling process for the headers of the photographs was disruptive to the normal publication process and added to the overall time for issuing patents. The more modern Office processing of drawings for utility and design applications now requires only a single set of formal drawings. When an application is allowed, the set of drawings in the application file is optically scanned and the images are stored in a patent publishing database. Copies of the drawings generated from the patent publishing database include the appropriate patent header information and are acceptable for all uses, including the preparation of Official Gazette notices, printed patents for the search rooms, and for sales by the PTCS Office, as well as for the original patent grant sent to the patentee.

Scanning of black and white photographs now results in sufficient image quality that the special handling process described above is no longer necessary. Accordingly, the PTO can now process black and white



cycle time of applications with photographs) and misuses valuable resources for several reasons. First, the petitions take time to decide, which adds to the processing time of applications with black and white photographs. Second, an added delay is caused by the practice of applicants first filing petitions under 37 C.F.R. 1.84(b)(1) while applications are being prepared for issuance and are no longer in the Technology Centers, where such petitions are decided, which requires applications with the petition and photograph(s) to be returned to the Technology Centers for treatment of the petitions. For these reasons, the requirement of 37 C.F.R. 1.84(b)(i) for a petition and petition fee should be eliminated.

This change in procedure should not change the number of applications in which photographs are filed. Photographs continue to be acceptable only in applications in which the invention is not capable of being illustrated in an ink drawing or where the invention is shown more clearly in a photograph. For example, photographs or photomicrographs of electrophoresis gels, blots, e.g., immunological, western, Southern, and northern, autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, metallurgical microstructures, textile fabrics, grain structures, and ornamental effects continue to be acceptable.

If a photograph that is filed in an application shows an invention which is capable of illustration, the examiner will, pursuant to 37 C.F.R. 1.81(c) and/or 37 C.F.R. 1.83(c), require a drawing of the subject matter. For example, syringes are capable of being drawn and drawings would generally demonstrate the details thereof more clearly (for example, cross hatching can be included to show the materials used). If a photograph (or a copy of a photograph) of a syringe is filed with the application, the examiner should require a drawing in lieu of the photograph. If the subsequently submitted drawing contains new matter, however, the examiner will not approve entry of the drawing, so applicants should be careful when initially submitting photographs instead of drawings. See MPEP 608.02(h) and 608.04. (The issue of new matter can also arise if a poor quality photograph or a photocopy of a photograph which is a poor reproduction is originally submitted and a better quality or the original photograph is later submitted and shows details beyond that shown in the photograph or photocopy that was originally submitted.)

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